

30.(Amended) A method of protecting a keratinous fiber from extrinsic damage or repairing a keratinous fiber following extrinsic damage comprising

applying to said keratinous fiber a composition comprising at least one sugar chosen from C3 to C5 monosaccharides and derivatives thereof; and

heating said keratinous fiber,

wherein said at least one sugar is present in an amount effective to protect said keratinous fiber or repair said keratinous fiber,

further wherein said composition is applied prior to said heating or during said heating,

wherein protecting a keratinous fiber means preserving a greater degree of the α -structure and/or the tensile strength of the keratinous fiber following treatment of the keratinous fiber with said composition as compared to not treating the keratinous fiber with said composition; and

wherein repairing a damaged keratinous fiber means increasing the α -structure and/or tensile strength of the damaged keratinous fiber following treatment of the damaged keratinous fiber with said composition as compared to not treating the keratinous fiber with said composition.

REMARKS

I. Status of the Claims

Claims 1-56 are pending in this application. Claim 30 has been amended to incorporate the definitions of "protecting" and "repairing" set forth in the specification

as originally filed at pages 5-6. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 U.S.P.Q.2d 1065, 1069 (Fed. Cir. 1999). Accordingly, these amendments merely expressly recite the definitions which were previously implicit. Accordingly, no new matter has been added and the claims were not narrowed by these amendments.

II. RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims:

- | | |
|-----------|--|
| Group I: | Claims 1-29, drawn to a method of protecting a keratinous fiber from extrinsic damage and a method of repairing a keratinous fiber following extrinsic damage, classified in class 424, subclass 70.1; and |
| Group II: | Claims 30-56, drawn to a method of protecting a keratinous fiber from extrinsic damage or repairing a keratinous fiber following extrinsic damage, classified in class 132, subclass 206. |

Applicants respectfully traverse the restriction requirement. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the invention of Group II, Claims 30-56.

Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, Applicants respectfully submit that the Examiner has not demonstrated that examining Groups I and II together will constitute a serious burden. The search and examination of Group I should overlap the necessary search and examination for Group II.

In view of the foregoing remarks, Applicants respectfully request that the restriction requirement be withdrawn.

III. Interview Summary

As discussed at the Interview held on September 18, 2002, Applicants maintain that U.S. Patent No. 4,900,545 ("*Wisotzki*") fails to anticipate the subject matter of the present claims.

A rejection under § 102 is only proper when the claimed subject matter, in this case a method, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

In the present case, *Wisotzki* discloses "[a] composition for the regeneration of hair split-ends in an aqueous or aqueous/alcoholic solution or emulsion containing panthenol, at least one mono- or di-saccharide, and optionally

polyvinylpyrrolidone and/or a triol." See Abstract. With respect to the at least one mono- or di-saccharide, *Wisotzki* discloses that "[g]lucose is preferably used." See col. 2, lines 47-48. Accordingly, each and every exemplified composition in *Wisotzki* comprises glucose monohydrate. Glucose is a C₆ monosaccharide.

In contrast, the present application is drawn to a method of protecting a keratinous fiber from extrinsic damage or repairing a keratinous fiber following extrinsic damage comprising, inter alia, applying to said at least one keratinous fiber a composition comprising at least one sugar chosen from C3 to C5 monosaccharides and derivatives thereof. Further, in Examples 2, 3, and 4 of the application as originally filed, Applicants have surprisingly demonstrated that pentoses provided statistically significant protection whereas water and hexoses do not. See e.g., pages 19, 21, 22, 23, 25. As C6 monosaccharides, such as the glucose disclosed by *Wisotzki*, do not protect or repair keratinous fiber as presently claimed, *Wisotzki* fails to anticipate the presently claimed invention.

IV. Conclusion

Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Application No. 09/614,118
Attorney Dock t No. 05725.0393

Please grant any extensions of time required to enter this response and
charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

Malvia V. Wc A, Reg. No. 39,064

By: *for Anthony C. Tridico*

Anthony C. Tridico
Reg. No. 45,958

Dated: October 17, 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com